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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,724

08/20/2003

Paul Edwin Jones

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EXAMINER

JUNTIMA, NITTAYA

ART UNIT

PAPER NUMBER

2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/645,724		JONES ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Nittaya Juntima		2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-36 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/20/03</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because in line 8, a period should be inserted after “to a delay point.” Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities:

- on page 3, lines 18-19, “in a call back...situation” should be replaced with “for maintenance purposes” and

- lines 20-21, “for maintenance purposes” should be replaced with “in a call back busy signal situation” in order to be consistent with the drawing

Appropriate correction is required.

### *Claim Objections*

3. Claims 2-4, 10-14, 19-20, and 22-30 are objected to because of the following informalities:

- in claims 2, 3, and 4, line 1, “wherein” should be inserted after “claim 1,” to put the claims in a better form;

- in claims 10, 11, 12, line 1, “wherein” should be inserted after “claim 5,” to put the claims in a better form;

- in claim 13, line 5, “the method comprising” should be inserted after “claim 5,” to put the claims in a better form;

- in claim 14, line 1, “the method comprising” should be inserted after “claim 5,” and

Art Unit: 2616

“further comprising” should be replaced with “which comprises” in order to put the claim in a better form;

- in claims 19 and 20, line 1, “the method comprising” should be inserted after “claim 15,” and “comprising” should be replaced with “which comprises” in order to put the claim in a better form;

- in claims 22-25, line 1, “wherein” should be inserted after “claim 21,” to put the claims in a better form;

- in claims 26-30, line 1, “wherein” should be inserted after “claim 26,” to put the claims in a better form;

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

4. Claims 26-34 claim “An article of *machine readable media* containing instructions that, when executed, cause *the machine* to:.” The claimed subject matter is nonstatutory functional descriptive material as stated in the MPEP 2106 Patentable Subject Matter. It is suggested that the applicant rewrite claims 26 and 31 in terms of “An article of *computer readable media* storing *computer executable instructions* which cause *the computer* to:.”

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 20, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 9 and 30, the phrase "etc." renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "etc."), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

In claim 20, "the user" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 10, 13, 15-24, 26-29, and 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Riikonen (US 2004/0162094 A1).

Regarding claim 1, as shown in Fig. 2, Riikonen teaches a network device, comprising:

A port (a caller terminal must include an output port for sending out an INVITE message) to allow the device to communicate with a called endpoint (callee terminal).

A process (a caller terminal must include a process for processing the messages shown in Fig. 2) to:

Send a call request message (INVITE F1) associated with a call to the called

Art Unit: 2616

endpoint (paragraph 0024).

Indicate a desire to delay call establishment until a delay point (the downloading and presentation of the multimedia content) is reached (the downloading and presentation of the multimedia content, which must be complete by the callee terminal, are indicated in a form of a URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message as shown in Fig. 3, paragraphs 0014, 0024, and 0027).

Regarding claim 2, Riikonen teaches that the processor further to receive a notification that a delay point has been reached (the 180 ringing message is sent from the callee terminal to the caller terminal after the downloading and presentation of the multimedia content is complete, paragraph 0027).

Regarding claim 3, Riikonen teaches that the processor to determine if the call is to be established and, if the call is to be established, notify the called endpoint (the caller terminal must determine that the multimedia session is to be established before transmitting an ACK message F9 and starting the multimedia session in F10, Fig. 2 and paragraph 0029).

Regarding claim 4, Riikonen teaches that the network device comprising a calling endpoint (caller terminal, Fig. 2).

Regarding claim 5, Riikonen teaches a method of delaying call establishment, the method comprising:

Transmitting a call request message (INVITE F1) associated with a call to a called endpoint (callee terminal) identifying a delay point (the downloading and presentation of the multimedia content, which must be complete by the callee terminal, are indicated in a form of a

URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message as shown in Fig. 3, paragraphs 0014, 0024, and 0027).

Regarding claim 6, Riikonen teaches receiving a notification from the called endpoint that the delay point has been reached (the 180 ringing message is sent from the callee terminal to the caller terminal after the downloading and presentation of the multimedia content is complete, Fig. 2 and paragraph 0027).

Regarding claim 7, Riikonen teaches determining if the call is to be established (the caller terminal must determine that the multimedia session in F10 is to be established before transmitting to the callee terminal an ACK message F9 and starting the multimedia session in F10, Fig. 2 and paragraph 002).

Regarding claim 8, Riikonen further teaches notifying the called endpoint if the call is to be established (ACK in F9 is sent from the caller terminal to the callee terminal before starting the multimedia session in F10, Fig. 2, paragraph 0029).

Regarding claim 10, Riikonen further teaches transmitting a call request message comprising transmitting a session initiation protocol INVITE message (a SIP INVITE message F1 in Fig. 2, paragraph 0024).

Regarding claim 13, Riikonen teaches receiving a notification from the called endpoint (callee terminal) comprising a Delay Point Reached message (the 180 ringing message F7 in Fig. 2 is used to notify the caller that the downloading and presentation is complete, paragraph 0027).

Regarding claim 15, as shown in Fig. 2, Riikonen teaches a method of delayed call establishment, the method comprising:

Receiving a call request message (INVITE in F1) associated with a call indicating a need for delayed call establishment and identifying a delay point (the downloading and presentation of the multimedia content, which must be complete by the callee terminal, are indicated in a form of a URL of the multimedia content in a new header Synchronize-Loading of the SIP INVITE message as shown in Fig. 3, paragraphs 0014, 0024, and 0027).

Regarding claim 16, Riikonen teaches transmitting a response indicating availability of delayed call establishment and progressing the call to the delay point (a 183 session progress message in F4 is sent from the callee terminal to the caller terminal and download process begins in F5, Fig. 2 and paragraphs 0025-0026).

Regarding claim 17, Riikonen teaches notifying a calling endpoint that the delay point has been reached (the 180 ringing message is sent from the callee terminal to the caller terminal after the downloading and presentation of the multimedia content is complete, Fig. 2 and paragraph 0027).

Regarding claim 18, Riikonen teaches processing the call as indicated by the calling endpoint (Fig. 2 and paragraphs 0025-0028).

Regarding claim 19, Riikonen also teaches processing the call which comprises alerting a use, of the called endpoint, of the call (paragraph 0027).

Regarding claim 20, Riikonen also teaches processing the call which comprises performing other tasks without alerting a user (tasks performed in F2-F6 shown in Fig. 2, paragraphs 0025-0027).

Regarding claim 21, as shown in Fig. 4, Riikonen teaches a network device (callee terminal), comprising:



A port (user interface) to allow the device to communicate with a calling endpoint (caller terminal, Fig. 2 and paragraph 0033).

A processor (a processor must be included in the caller terminal to process the steps performed in Fig. 2) to:

Receiving a call request message (INVITE F1, Fig. 2) associated with a call from the calling endpoint (paragraph 0024).

Respond with a notification of delayed call establishment availability and process the call to a delay point (a 183 session progress message in F4 is sent from the callee terminal to the caller terminal and download process begins in F5, Fig. 2 and paragraphs 0025-0026).

Regarding claim 22, Riikonen teaches that the processor further to transmit a notification that a delay point has been reached (the 180 ringing message is sent from the callee terminal to the caller terminal after the downloading and presentation of the multimedia content is complete, paragraph 0027).

Regarding claim 23, Riikonen teaches that the processor to determine if the call is to be established and, if the call is to be established, notify the called endpoint (the callee terminal must determine that the multimedia session is to be established before transmitting alerting the callee in F7 and starting the multimedia session in F10, Fig. 2 and paragraphs 0027 and 0029).

Regarding claim 24, Riikonen teaches that the network device comprising a called endpoint (callee terminal in Figs. 2 and 4, paragraph 0033).

Claims 26-29 are article of computer-readable media storing computer executable instructions claims corresponding to method claims 5-8, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 5-8, respectively (caller terminal must

Art Unit: 2616

contain an article of computer-readable media storing computer executable instructions in order to process SIP messages shown in Fig. 2).

Claims 31-34 are article of computer-readable media storing computer executable instructions claims corresponding to method claims 15-18, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 15-18, respectively (callee terminal must contain an article of computer-readable media storing computer executable instructions in order to process SIP messages shown in Fig. 2).

Claim 35 is a network device claim containing similar limitations to the network device claim 1, and is therefore, rejected under the same reason set forth in the rejection of claim 1.

Claim 36 is a network device claim containing similar limitations to the network device claim 21, and is therefore, rejected under the same reason set forth in the rejection of claim 21.

8. Claims 5, 9, 26, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Donovan (US 6,366,577 B1).

Regarding claim 5, as shown in Fig. 2, Donovan teaches a method of delaying call establishment, the method comprising:

Transmitting a call request message (SIP INVITE) associated with a call to a called endpoint identifying a delay point (SIP INVITE message 1 associated with a call to a called endpoint, e.g., 2 in Fig. 1, is sent from SIP1 150 to SIP2 152 requesting QoS which preventing the called telephone not to ring until policy ensuring the QoS has been provisioned, col. 6, lines 63-65, see also col. 4, lines 34-39).

Regarding claim 9, Donovan also teaches performing maintenance testing without notifying the called endpoint to start alerting a called user, wherein maintenance comprises

service level verification (Fig. 2 shows that SIP1 150 sends a COPS REQ AAA message 2 to verify the QoS policy for user, col. 4, lines 15-39, col. 6, lines 49-60).

Claims 26 and 30 are article of computer-readable media storing computer executable instructions claims corresponding to method claims 5 and 9, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 5 and 9, respectively (the machine reads on SIP1 150 which must contain an article of computer-readable media storing computer executable instructions in order to process messages shown in Fig. 2).

### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riikonen (US 2004/0162094 A1).

Regarding claim 11, Riikonen fails to explicitly teach the step of transmitting a call request message comprising transmitting an H.323 Setup message. An official notice is taken that it is well known in the art that a Setup message of H.323 protocol is equivalent to an INVITE message of SIP protocol and H.323 protocol is widely used as a protocol for setting connection/session as an alternative to the SIP protocol. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the teaching of Riikonen to include transmitting an H.323 Setup message as claimed. The suggestion/motivation to do so would

have been to utilize H.323 protocol as an alternative to SIP in order to support H.323 devices, and such modification involves only routing skills in the art.

Regarding claim 25, Riikonen fails to teach that the calling endpoint (caller terminal in Fig. 2) comprising an intermediary. However, Riikonen further teaches that a SIP application server may be used between the caller and the callee (paragraph 0031). Therefore, it would have been obvious to one skilled in the art at the time of the invention to further modify the teaching of Riikonen to include a SIP application server such that the calling endpoint would comprise an intermediary (a SIP application server) as claimed. The suggestion/motivation to do so would have been to allow the calling endpoint not to have to include the modified SIP functionality by having the intermediary, such as a SIP application server, acting as its gateway (Riikonen, paragraph 0031).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riikonen (US 2004/0162094 A1) in view of McDysan (US 7,046,680 B1).

Regarding claim 14, Riikonen does not teach notifying the called endpoint further comprising sending a Delayed Call Establishment Release message.

However, McDysan teaches SIP call termination in which the caller initiates call termination by sending a BYE request which is forwarded to a callee (equivalent to notifying the called endpoint which comprises sending a Delayed Call Establishment Release message). See col. 24, lines 23-43.

Given the teaching of McDysan, it would have been obvious to one skilled in the art at the time of the invention to modify the teaching of Riikonen to include SIP call termination such that the step of notifying the called endpoint which comprises sending a Delayed Call

Establishment Release message would be included as claimed. The suggestion/motivation to do so would have been to enable the caller to terminate the call (McDysan, col. 24, lines 28-31).

*Allowable Subject Matter*

12. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated

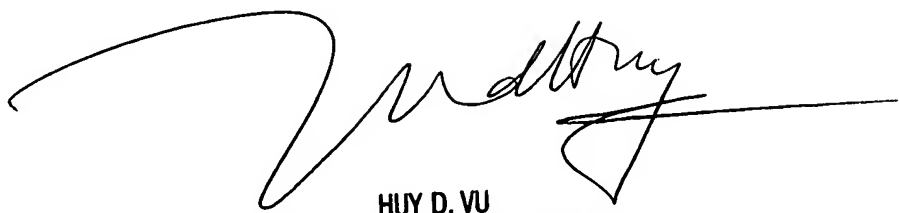
Art Unit: 2616

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nittaya Juntima

March 26, 2007

*NJ*

A large, stylized handwritten signature in black ink, likely belonging to Huy D. Vu, is positioned above the printed name and title.

HUY D. VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600